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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREA FINKE-ANLAUFF, ANNIKA MACKE, DANIELA SCHULTEN, CHRISTIAN LINDHOLM, SAMI KOSKELA, and TUOMAS ARTMAN

Appeal 2009-005668
Application 10/774,670[1]
Technology Center 2100

Before JAMES D. THOMAS, ST. JOHN COURTENAY III, and JAMES R. HUGHES, *Administrative Patent Judges*.

HUGHES, *Administrative Patent Judge*.

DECISION ON APPEAL[2]

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[1] Application filed February 9, 2004. The real party in interest is Nokia Corp. (App. Br. 1.)

[2] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants appeal from the Examiner's rejection of claims 1-9, 35-39, 48, and 49 under authority of 35 U.S.C. § 134(a). Claims 10-34 and 40-47 have been withdrawn. (App. Br. 2.) The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' Invention

The invention at issue on appeal relates to a device and computer – readable instructions for providing a media application for displaying media file representations facilitating location and viewing of a media file by a user. The application associates digital media files with a period of time and generates media file representations within a media view such that the media file representations associated with a period of time proximate to a predefined position within the media view are enlarged media file representations. (Spec. ¶¶ [0008]-[0009].)[3]

Representative Claim

Independent claim 1further illustrates the invention. It reads as follows:

> 1. A computer readable storage medium having computer-readable program instructions embodied in the medium, the computer-readable program instructions configured to be executed by a processing device to provide access to media files on a digital device, the computer-readable program instructions comprising:

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[3] We refer to Appellants' Specification ("Spec."); Appeal Brief ("App. Br.") filed February 21, 2008; and Reply Brief ("Reply Br.") filed July 10, 2008. We also refer to the Examiner's Answer ("Ans.") mailed May 14, 2008. Specification paragraph numbers reference Publication No. 2005/0187943.

> first instructions for generating a media view that provides access to at least one digital media file and associates the at least one digital media file with a period of time; and
>
> second instructions for generating media file representations within the media view such that the media file representations associated with a period of time are enlarged media file representations when the period of time is proximate a predefined position within the media view.

References

The Examiner relies on the following references as evidence of unpatentability:

Yang	US 6,301,568 B1	Oct. 9, 2001
Hayashi	US 2002/0054157 A1	May 9, 2002

Rejections on Appeal

The Examiner rejects claims 1, 4, 5, 35, and 38 under 35 U.S.C. § 102(b) as being anticipated by Yang.

The Examiner rejects claims 2, 3, 6-9, 36, 37, 39, 48, and 49 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Yang and Hayashi.[4]

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[4] We note that the Examiner and Appellants acknowledge that claims 48 and 49 are included in Appellants' appeal – *see* App. Br. 2 and Ans. 2 – but the Examiner omits these claims from the statement of the §§ 102 and 103 rejections, and Appellants do not discuss these claims in their Briefs – *see* Ans. 3, 5 and App. Br. 4, 5, 8, 10. Claims 48 and 49 depend on claims 1 and 35, respectively. In the Final Rejection Office Action Summary (mailed July 19, 2007), the Examiner indicates that claims 48 and 49 are rejected. Since the Examiner has indicated that claims 48 and 49 stand rejected, and Appellants have failed to discuss these claims, we revise the statement of the § 103 rejection to include claims 48 and 49.

ISSUE

Based on our review of the administrative record, Appellants' contentions, and the Examiner's findings and conclusions, the pivotal issue before us is as follows:

Does the Examiner err in finding Yang discloses generating media file representations within the media view such that the media file representations associated with a period of time are enlarged media file representations when the period of time is proximate a predefined position within the media view as recited in Appellants' claim 1?

FINDINGS OF FACT (FF)

We adopt the Examiner's findings in the Answer and Final Office Action as our own, except as to those findings that we expressly overturn or set aside in the Analysis that follows. We also add the following factual findings:

Yang Reference

1. Yang describes a "multimedia object management application" or system ("MOMA") (col. 5, ll. 3-7) that allows users to "organize and manage image/media files with associated properties such as . . . date [and] time" (col. 5, ll. 44-46, *see* Fig. 6 – showing date range identifying thumbnails). The MOMA organizes the media files into albums, which contain representations (icons or thumbnails) for each of the media files. The files (representations of files) may be viewed in a notebook, spreadsheet or thumbnail view.

2. Yang's notebook view presents tabs (representing albums), and each tab displays representations (thumbnails or icons) of media file within the album with database information associated with the file. (Col. 6, ll. 3-5; col. 21, ll. 33-46; Figs. 8, 26.) Yang describes a page in the notebook (representing a media file) may display an enlarged representation of a particular media file along with data for the media file, navigation buttons and a slideshow activation button – *see* Fig. 26.

3. Yang's spreadsheet view provides text information for each file in an album, and provides a pop-up thumbnail (preview) for non-text information. (Col. 6, ll. 5-12; col. 21, l. 48 to col. 22, l. 10; Figs. 8, 27.)

4. Yang describes the thumbnail view as the basic or default MOMA view method. All the media files in an album can be viewed as thumbnails, which can be organized according to a customized field name. (Col. 22, l. 60 to col. 23, l. 5; Fig. 32.) As illustrated in Figure 6, the field name may be a date range. Additionally, Yang describes filtering the files (displayed file representations) according to selected criteria – for example, a date range. (Col. 24, ll. 35-39.) Yang's files may be viewed either within the view window, in which the thumbnails are displayed, or in a full screen view. (Col. 23, ll. 6-11.) The viewer can also display the files in a manual or an automatic (slide show) mode. (Col. 14, ll. 46-51; col. 23, ll. 12-23.) Yang further describes that the user can configure the size of the displayed image. (Col. 14, ll. 46-51; col. 23, ll. 29-31; Fig. 32.)

ANALYSIS

Appellants argue independent claims 1 and 35, as well as dependent claims 4, 5, and 38 together as a group with respect to the Examiner's

anticipation rejection. (App. Br. 5, 8.) Therefore, we select independent claim 1 as representative of Appellants' arguments and grouping with respect to the Examiner's anticipation rejection. Appellants also argue dependent claims 2, 3, 6-9, 36, 37, and 39 together as a group with respect to the Examiner's obviousness rejection. (App. Br. 8-10.) We also include claims 48 and 49 in this group – *see* FN 4, *supra*. Therefore, we select independent claim 2 as representative of Appellants' arguments and grouping with respect to the Examiner's obviousness rejection. 37 C.F.R. § 41.37(c)(1)(vii). *See In re Nielson*, 816 F.2d 1567, 1572 (Fed. Cir. 1987). We have considered only those arguments that Appellants have actually raised in their Brief. Arguments that Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellants have the opportunity on appeal to the Board of Patent Appeals and Interferences (BPAI) to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (citing *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). The Examiner sets forth a detailed explanation of a reasoned conclusion of anticipation in the Examiner's Answer with respect to representative claim 1. (Ans. 4, 8-10). The Examiner also sets forth a detailed explanation of a reasoned conclusion of obviousness in the Examiner's Answer with respect to representative claim 2. (Ans. 5-6, 10-11.) Therefore, we look to the Appellants' Brief to show error in the proffered reasoned conclusions. *See Kahn*, 441 F.3d at 985-86.

Arguments Concerning the Examiner's Rejection of Claim 1 under 35 U.S.C. § 102(b)

Appellants contend that Yang does not disclose Appellants' recited second instructions for generating media file representations within the media view such that the media file representations associated with a period of time are enlarged media file representations when the period of time is proximate a predefined position within the media view. (App. Br. 5-8; Reply Br. 2-4.) Specifically, Appellants argue that "it is the position of the period of time relative to a predefined position within the media view that determines whether or not associated media file representations will be enlarged" (Reply Br. 4), and the sizing of media file representations in Yang is "unrelated to the position of a time within any type of 'media view'" (App. Br. 8).

The Examiner finds that Yang discloses each feature of Appellants' claim 1, and provides a detailed explanation as to why Appellants' arguments fail to overcome the Examiner's anticipation rejection. (Ans. 4, 8-10.) Specifically, the Examiner finds that Yang discloses a media object management application "MOMA" that organizes media files according to properties such as date and time, and displays media file representations. The Examiner also finds that Yang displays enlarged representations of the media files (e.g., a full screen slide show image relative to a thumbnail image) when a time period associated with the representation (i.e., a media file representation associated with a time period) is near the center of the screen. (Ans. 8-10.)

Based on the record before us, we do not find error in the Examiner's anticipation rejection of representative claim 1. We agree with the Examiner

that Yang discloses the disputed features. We begin our analysis by construing Appellants' disputed claim limitations.

We give claim terminology the "broadest reasonable interpretation consistent with the [S]pecification" in accordance with our mandate that "claim language should be read in light of the [S]pecification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (citations omitted). We note that Appellants' representative claim 1 recites "such that the media file representations associated with a period of time are enlarged media file representations when the period of time is proximate a predefined position within the media view." Appellants do not explicitly define, in their Specification or in claim 1, an "enlarged media file representation" or a "predefined position within the media view." Consequently, we find that the Appellants' disputed claim limitation at most recites an intended use or purpose of the storage medium having second instructions (for generating (displaying) media file representations within the media view). Appellants' claim does not positively recite that a media file representation is actually enlarged, nor does the claim define or limit the manner of determining when "the period of time" is near (proximate) a particular "predefined position within the media view." We note that "[a]n intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates." *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003). Although "[s]uch statements often . . . appear in the claim's preamble," *In re Stencel*, 828 F.2d 751, 754 (Fed. Cir. 1987), a statement of intended use or purpose can appear elsewhere in a claim. *Id.*

Thus, Appellants' claim recites an intended use or purpose of the storage medium having second instructions that may never actually occur. The storage medium is an apparatus, not a process. Accordingly, if the prior art structure is capable of performing the intended use, it meets the claim limitation. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647, 1648 (BPAI 1987). Similarly, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78 (Fed. Cir. 1997). "[A]pparatus claims cover what a device *is*, not what a device *does*." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1468 (Fed. Cir. 1990). Put simply, how an apparatus invention is used is not germane to whether it is anticipated by the prior art.

Moreover, even if we were to attribute some weight to Appellants' statement of intended use, *arguendo*, we agree with the Examiner that Yang discloses the disputed feature. Appellants' explain that:

> Additionally, the file management application may provide for a timeline view that is typically displayed in conjunction with the media view or a combined media view and calendar view. The timeline view provides for a timeline presentation (referred to as a "time bar") of media items and, in certain embodiments, calendar events and reminders. *See* ¶ 0028.

(App. Br. 3.) Appellants' also explain that:

> The computer-readable program instructions of independent Claim 1 also include second instructions for

> generating media file representations within the media view such that the media file representations associated with a period of time are enlarged media file representations when the period of time is proximate a predefined position within the media view. For example, as shown in the media view 200 of Fig. 2, the media file representations (230A, 250A, 270A...) may have respective sizes that are determined by the distance from the vertical centerline of the associated time period, time frame or event. *See* ¶ 0049. Alternatively, the size of a media file representation can be determined in terms of the distance from any predefined position within the media view. *See* ¶ 0050.

(App. Br. 4; *see also* Reply Br. 3-4.) Appellants' Specification (at paragraphs 49 and 50), in pertinent part, describes that:

> FIG. 2 provides for a media view in which the media items are presented in a "cylindrical" media view. The "cylindrical" media view 200 provides for *the size of the media file representation to be determined by the distance from the vertical centerline of the associated time period*, time frame or event . . . . [W]hile the FIG. 2 illustrated embodiment determines size of the media file representation in terms of *the distance from the vertical centerline of the associated time period*, time frame or event (i.e., a column in FIG. 2), it is also possible, and within the inventive concepts herein disclosed, to determine size of the media file representation in terms of the distance from any predefined position within the media view and to have other displayed media file representations vary in size according to the distance from the predefined position.

(Spec. ¶¶ 49-50 (emphasis added).) Based on a broad but reasonable interpretation of Appellants' disputed claim limitation in light of Appellants' Specification and their explanation in their Briefs, we find that Appellants' recited second instructions determine the media file representation size "in terms of the distance from [the predefined position] of the associated time period." (*Supra* – Spec. ¶¶ 49-50.) In other words, the distance of the

representation from a predetermined position associated with a particular time period, such as a date on a calendar or time line.

As detailed in the Findings of Fact section *supra*, Yang describes generating/displaying a window (media view) and associating media files with a period of time. Yang also describes displaying thumbnails (media file representations) within the window (media view). Yang further describes enlarging the thumbnails manually or automatically. (FF 1-4.) Yang's thumbnails may be filtered and organized according to a date range (FF 1, 4), and the files may then be displayed in a slide show (FF 2, 4). Alternatively, the thumbnail may be selected by a user and an enlarged image may be displayed in the window (FF 4) or on a page of a notebook view (FF 2). Yang also describes a preview when a user positions a cursor over or selects non-text information in a spreadsheet view. (FF 3.) We see no functional distinction between appellants disputed claim limitation and Yang's disclosure of organizing media files in order of date and enlarging the file representations (e.g., from a thumbnail to a larger image in a slide show when the representation is near a user determined (predetermined) position in the window).

Appellants' arguments (*supra*) seem to imply that an image is automatically enlarged when the image is near a certain predetermined position in a view – "it is the position <u>of the period of time</u> relative to a predefined position within the media view that determines whether or not associated media file representations will be enlarged" (Reply Br. 4). However, Appellants' argument is not commensurate with the scope of their claim. The claim merely recites generating media file representations "<u>*such that*</u>" (emphasis added) the representations "are enlarged" when "the period

of time is proximate a predefined position within the media view." Appellants do not define nor limit the position or the process of determining when to enlarge a representation. Consequently any position (or positions) within a view may be broadly but reasonably interpreted to be the recited "predefined position." For, example, as noted by the Examiner, the center of the window is such a predefined position when a full screen view is utilized. (Ans. 10.) Further, the claim does not preclude user intervention as Appellants seem to suggest. The claim does not recite automatically enlarging the representation, and we note that a claimed invention is not patentable if it merely automates a prior art process. *See In re Venner*, 262 F.2d 91, 95 (CCPA 1958); *cf. Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007). Further, the claim utilizes the open-ended term "comprising," which reinforces this interpretation. *See Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501 (Fed. Cir. 1997).

We therefore find that Yang discloses generating thumbnails (media file representations) associated with a period of time (e.g., a date range identifier) within a window (media view), as well as enlarging the thumbnails when the thumbnail associated with the period of time is near (proximate) a predefined position within the window – e.g., a user selected position within the window, such as the center. Thus, a broad but reasonable interpretation of Appellants' claim 1 reads on at least one embodiment of Yang. We find Appellants' contrary arguments unpersuasive, for the reasons set forth above. Appellants do not provide any persuasive evidence or argument that Yang fails to disclose the disputed feature. Thus, we find Yang discloses Appellants' disputed claim limitation as recited in Appellants' independent claim 1. Appellants do not separately argue

independent claim 35 or dependent claims 4, 5, and 38 (*supra*). We, therefore, find Yang anticipates Appellants' claims 4, 5, 35, and 38 for the reasons set forth with respect to representative claim 1. It follows that Appellants do not persuade us of error in the Examiner's anticipation rejection of claims 1, 4, 5, 35, and 38, and we affirm the Examiner's rejection of these claims.

Arguments Concerning the Examiner's Rejection of Claim 2 under 35 U.S.C. § 103(a)

Appellants contend that that neither Yang, nor Hayashi teach the disputed feature discussed with respect to claim 1. (App. Br. 8-10; Reply Br. 4.) As we explain *supra*, Yang fully describes the disputed limitation which we construe to mean generating media file representations associated with a period of time within a media view, and enlarging the media file representations when the representations associated with the period of time are near a predefined position within the view.

Thus, we find Yang teaches (and Yang and Hayashi collectively teach) Appellants' disputed claim limitation as recited in Appellants' independent claim 1 and dependent claim 2. Appellants do not separately argue dependent claims 3, 6-9, 36, 37, 39, 48, and 49 (*supra*). We, therefore, find Yang and Hayashi collectively render Appellants' claims 3, 6-9, 36, 37, 39, 48, and 49 obvious for the reasons set forth with respect to representative claim 2. It follows that Appellants do not persuade us of error in the Examiner's obviousness rejection of claims 2, 3, 6-9, 36, 37, 39, 48, and 49, and we affirm the Examiner's rejection of these claims.

CONCLUSIONS

Appellants have not shown that the Examiner erred in rejecting claims 1, 4, 5, 35, and 38 under 35 U.S.C. § 102(b).

Appellants have not shown that the Examiner erred in rejecting claims 2, 3, 6-9, 36, 37, 39, 48, and 49 under 35 U.S.C. § 103(a).

DECISION

We affirm the Examiner's rejection of claims 1, 4, 5, 35, and 38 under 35 U.S.C. § 102(b).

We affirm the Examiner's rejection of claims 2, 3, 6-9, 36, 37, 39, 48, and 49 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v).

AFFIRMED

msc

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